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EXAMINER

MAUNG, ZARNI

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 31

Application Number: 09/191,256
Filing Date: November 12, 1998
Appellant(s): Robert Douglas Case et al.

MAILED

MAR 16 2004

Brian C. Kunzler
(Reg. No. 38,527)
For Appellant

Technology Center 2100

EXAMINER'S ANSWER

This is in response to the appellants' amended appeal brief filed on January 30, 2004.

REAL PARTY IN INTEREST

A statement identifying the real party in interest is contained in the brief.

RELATED APPEALS AND INTERFERENCES

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

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STATUS OF THE CLAIMS

The statement of the status of the claims contained in the brief is correct.

STATUS OF AMENDMENT

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

SUMMARY OF INVENTION

The summary of invention contained in the brief is correct.

ISSUES

The appellant's statement of the issues in the brief is correct.

GROUPING OF THE CLAIMS

The appellants' statement of the grouping of the claims in the brief is correct.

CLAIMS APPEALED

The copy of the appealed claims contained in the appendix pages 25-29 is correct.

PRIOR ART OF RECORD

U.S. Patent number 5,944,791, published on August 31, 1999, filed on October 4, 1996 by Scherpbier, (hereinafter Scherpbier).

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U.S. Patent Number 5,941,954, published on August 24, 1999, filed on October 1, 1997 by Kalajan (hereinafter Kalajan).

NEW PRIOR ART

No new prior art has been applied in this examiner's answer.

GROUND OF REJECTION

Claims 1-22 are rejected under 35 U.S.C. § 103 as obvious over Scherpbier et al., U.S. Patent Number 5,944,791 (hereinafter Scherpbier), in view of Kalajan, U.S. Patent Number 5,941,954 (hereinafter Kalajan).

As per claim 1, Scherpbier discloses a system and method for remotely controlling another client computer in a network (see abstract and figure 1). Scherpbier discloses the invention as claimed. As per claim 1, Scherpbier discloses a system for remotely accessing a client in a client server system comprising a browser for requesting remote access (see figure 1, pilot computer 18 with browser 20, column 3, line 40 to column 4, line 50); a client machine further comprised of a listening program responsive to requests for remote access from the browser and a client agent for communicating with the browser and a server machine (see figure 1, column 3, line 40 to column 6, line 54, the passenger computer browser 26, applets 28 which are computer software, for communicating with the pilot browser 20 and control or server computer 12).

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Scherpbier does not explicitly show that the browser establishes direct communication with the listening program associated with the client machine, because browser 20 establishes communication with the listening program through the control module 16. Kalajan, in the same field of endeavor, discloses that aspect of the invention. Kalajan discloses the listening program 20 executing on the client 10, which is communicating with the browser 22 directly (see column 2, lines 29-55, column 3, line 24 to column 4, line 17). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Scherpbier in view of Kalajan by including a listening program which is directly communicating with a browser, because Kalajan suggests the use of such program to provide resources to network users in a transparent manner (see column 2, lines 17-64). One of ordinary skill in the art would have been motivated to modify Scherpbier in view of Kalajan by including a listening program which is directly communicating with a browser so that resources can be distributed transparently to the network users.

As per claim 2, Scherpbier discloses the system for remotely accessing a client in a client server system as claimed in claim 1, wherein the browser requests access to a client machine by sending a universal resource locator containing a machine name and a port number over a network (see column 4, line 30 to column 5, line 54, flight request including identification of the intended passenger computer with browser 26,

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passenger applets 28. The passenger computer 24 accesses the control module using browser 26 and appropriate URL to download boarding applet).

As per claim 3, Scherpbier discloses the system for remotely accessing a client in a client server system as claimed in claim 2, wherein the listening program in the client machine is listening on the port number, and establishes communications with the browser over a second port number in response to the request for access (see column 4, line 30 to column 5, line 54; port number for applet 28 and internet port number 80 for browser are inherent).

As per claim 4, Scherpbier discloses the system for remotely accessing a client in a client server system as claimed in claim 3, wherein the listening program spawns the client agent to communicate with the browser and the server (see column 4, line 30 to column 5, line 54; applet 28).

As per claim 5, Scherpbier discloses the system for remotely accessing a client in a client server system as claimed in claim 4, wherein the client agent sends the browser an applet further comprising graphical user interface to execute on the browser (see column 4, line 30 to column 5, line 54, pilot applet 22, displays 18a, 24a of the computers).

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As per claim 6, Scherpbier discloses the system for remotely accessing a client in a client server system as claimed in claim 5, wherein the applet executes in the national language and locale of the browser (see column 3, line 40 to column 5, line 54; applets execute in HTML).

As per claim 7, Scherpbier discloses the system for remotely accessing a client in a client server system as claimed in claim 5, wherein the browser is located on the server machine (see figure 1, column 3 line 40 to column 5, line 54; browsers on the pilot and server computers).

As per claim 8, Scherpbier discloses the system for remotely accessing a client in a client server system as claimed in claim 5, wherein the graphical user interface is a command line interface (see column 5, lines 1-35; the command line interface in displays 18a, 24a of the computers).

As per claims 9-22, they do not teach or further define over the limitations recited in claims 1-8. Therefore, claims 9-22 are also rejected for the same reasons set forth in claims 1-8, supra.

Response to Argument

The examiner summarizes the various points raised by the appellant and addresses replies individually.

As per appellants' arguments filed on January 30, 2004, the appellants argued in substance that "Claim 1-22 are not obvious under 35 U.S.C. § 103 because the Scherpbier reference and the Kalajan reference do not contain all the limitations of the present invention" (see page 5 of the Brief). Specifically, Scherpbier and Kalajan fail to disclose "... a client machine further comprised of a listening program configured to be responsive to requests for remote access from the browser, establish direct communications therewith, and invoke a client agent for communicating with the browser and the server machine (see page 7 of the Brief).

In reply, Scherpbier and Kalajan in combination teaches all the limitations recited in the claims. Scherpbier discloses a system and method for remotely controlling another client computer in a network (see abstract and figure 1, pilot computer 18 controls the navigating systems or web browsers of one or more passenger computers). Scherpbier discloses a system for remotely accessing a client in a client server system comprising a browser for requesting remote access (see figure 1, pilot computer 18 with browser 20, column 3, line 40 to column 4, line 50); a client machine further comprised of a listening program responsive to requests for remote access and a client agent for communicating with the browser and a server machine (see figure 1, column 3, line 40 to column 6, line 54, the passenger computer browser 26, applets 28 which are computer software, for communicating with the pilot browser 20 and control or server

computer 12). Scherpbier does not explicitly show that the browser establishes direct communication with the listening program associated with the client machine, because browser 20 establishes communication with the listening program through the control module 16. Kalajan, in the same field of endeavor, discloses that aspect of the invention. Kalajan discloses the listening program 20 executing on the client 10, which is communicating with the browser 22 directly (see column 2, lines 29-55, column 3, line 24 to column 4, line 17). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Scherpbier in view of Kalajan by including a listening program which is directly communicating with a browser, because Kalajan suggests the use of such program to provide resources to network users in a transparent manner (see column 2, lines 17-64). One of ordinary skill in the art would have been motivated to modify Scherpbier in view of Kalajan by including a listening program which is directly communicating with a browser so that resources can be distributed transparently to the network users.

The appellants further argued that Scherpbier does not disclose "a client machine further comprised of a listening program responsive to requests for remote access" (see pages 8, 9-13 of the Brief).

In reply, Scherpbier does show a client machine (passenger computers 24) further comprised of a listening program (applet 28 associated with the browser 26) responsive to requests for remote access from the browser (see column 3, line 50 to column 4, line 11; "The pilot applet 22 can cause the pilot Web browser 20 to communicate with the control module 16 via a computer network..., the applet 28

causes the passenger browser 26 to communicate with the control module 16 via the internet 23”) as claimed. Scherpbier discloses that the pilot applet 22 can cause the pilot web browser 20 to communicate with the control module 16 via a computer network. “Similarly, the passenger computer 24 has a passenger Web browser 26”. The passenger applet 28 causes the passenger browser 26 to communicate with the control module 16 via the internet. Scherpbier further states “the pilot computer 18, at block 42, to transmit a flight request to the control module 16 using HTTP protocol. This flight request lists one or more Web pages to which the user of the pilot computer 18 wishes to guide the passenger computer (s) 24. Also, the flight request can include other data, such as the identifications of the intended passenger computers” (see column 4, lines 30-67). Therefore, Scherpbier clearly teaches that the browser 26 and passenger applet 28 respond to the request from the browser 20 via the network.

The appellants further argue that Scherpbier does not disclose “...wherein the browser request access to the client machine..” (see page 9 of the Brief).

In reply, it is clear from the above cited passages that Scherpbier discloses the browser request access to the client machine 24 via the network.

The appellants further argued that “Claims are not obvious under 35 U.S.C. § 103 because there is no motivation or suggestion to combine the Kalajan reference with the Scherpbier reference (see pages 14-15 of the Brief).

In reply, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so

found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Scherpbier does not explicitly show that the browser establishes direct communication with the listening program associated with the client machine, because browser 20 establishes communication with the listening program through the control module 16. Kalajan, in the same field of endeavor, discloses that aspect of the invention. Kalajan discloses the listening program 20 executing on the client 10, which is communicating with the browser 22 directly (see column 2, lines 29-55, column 3, line 24 to column 4, line 17). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Scherpbier in view of Kalajan by including a listening program which is directly communicating with a browser, because Kalajan suggests the use of such program to provide resources to network users in a transparent manner (see column 2, lines 17-64). One of ordinary skill in the art would have been motivated to modify Scherpbier in view of Kalajan by including a listening program which is directly communicating with a browser so that resources can be distributed transparently to the network users.

The appellants further contend that "The examiner rejected claim 1 by picking and choosing isolated teachings from the Scherpbier and Kalajan references and pasting them together to recreate the claims..., the teaching to combine the prior art references is only found in the appellants' disclosure" (see pages 15-18 of the Brief).

In reply, the examiner did not pick or choose isolated teachings from the Scherpbier and Kalajan. Rather, Kalajan explicitly suggests the improvement for a system disclosed by Scherpbier. The examiner clearly stated that Scherpbier does not explicitly show that the browser establishes direct communication with the listening program associated with the client machine, because browser 20 establishes communication with the listening program through the control module 16.

Kalajan, in the same field of endeavor, discloses that aspect of the invention. Kalajan discloses the listening program 20 executing on the client 10, which is communicating with the browser 22 directly (see column 2, lines 29-55, column 3, line 24 to column 4, line 17). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Scherpbier in view of Kalajan by including a listening program which is directly communicating with a browser, because Kalajan suggests the use of such program to provide resources to network users in a transparent manner (see column 2, lines 17-64). One of ordinary skill in the art would have been motivated to modify Scherpbier in view of Kalajan by including a listening program which is directly communicating with a browser so that resources can be distributed transparently to the network users. The test of obviousness is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In re Keller, 642 F. 2d 414, 425, 208 USPQ 871, 881 (CCPA 1981); In re Young, 927 F. 2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). In this case, it would have been obvious for one of ordinary skill in the art to modify the Scherpbier in

view of Kalajan, because Kalajan explicitly suggests the use of such program to provide resources to network users in a transparent manner (see column 2, lines 17-64).

The appellants further argued that "Claims are not obvious under 35 U.S.C. § 103 because the prior art references represent different fields of endeavor from the present invention". To support their arguments, the appellants argued that "Neither Scherpbier nor Kalajan teach toward the field of endeavor of the present invention, remotely controlling a user-less client machine from a browser". (see pages 18-19 of the Brief).

In reply, the claimed invention is directed to "A system for remotely accessing a client in a client-server system". The claims merely call for remotely accessing a client in a client-server system. The claims are not directed to a user-less client machine or remotely controlling a user-less client machine from a browser. Scherpbier discloses a system 10 having a pilot computer 18 with browser 18 for remotely controlling a browser 26 on the passenger computer 24 (see figure 1). It is clear that Scherpbier discloses the subject matter that is related to the appellants' invention. Kalajan discloses "a software program from an HTTP-protocol server to an HTTP-protocol browser on the client,... the software program, when downloaded and executing on the client, being configured to listen to at least one communications port of the client during the communication session" (see column 2, lines 35-40). Kalajan disclosure itself explains that it is a server system for remotely accessing a client. Therefore, both of the cited references are in the same field of endeavor of the present invention. It is irrelevant

whether the cited references use a system without a user-less client machine or not, because the claims are not directed to a user-less system.

The appellants further argued that "Claims 1-22 are not obvious under 35 U.S.C. § 103 because the prior art references represent different purposes from the present invention" (see pages 19-20 of the Brief).

In reply, the appellant arguments that "prior art references represent different purposes" and that "The present invention teaches control of a remote client machine to facilitate functions such as storage management when no user is present to perform the function" are, once again, limitations that are not included in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The appellants further asserted that "Claims 1-22 are not obvious under 35 U.S.C. § 103 because the combination of the prior art references destroys the purpose and utility of the prior art invention" (see pages 20-22 of the Brief).

In reply, the argument that the combination of Scherpbier and Kalajan destroys the purpose and utility of the prior art invention, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re*

Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The appellants argument that "locating the browser on the server machine would destroy the purpose and utility of Scherpbier and Kalajan", the limitations are not recited in the rejected claims.

The appellants further argued that "Claims 1-22 are not obvious under 35 U.S.C. § 103 because the obviousness was found by the hindsight combination of components culled from the prior art", and "the Scherpbier and Kalajan could only be combined using the present invention as a template (see pages 19-20 of the Brief).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In this case, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Scherpbier in view of Kalajan by including a listening program which is directly communicating with a browser, because Kalajan suggests the use of such program to provide resources to network users in a transparent manner (see column 2, lines 17-64). One of ordinary skill in the art would have been motivated to modify Scherpbier in view of Kalajan by including a listening


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program which is directly communicating with a browser so that resources can be distributed transparently to the network users.

For the above reasons, it is believed that the rejections should be sustained.

March 12, 2004


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PRIMARY EXAMINER

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